REMARKS

Claims 155-193 are in the application.

The claims have been generally amended to omit the word "step", which is inferred from the method. It is respectfully submitted that these amendments do not alter the scope of the claims for examination.

An Information Disclosure Statement is provided herewith.

FORMAL REJECTIONS

Claim 177 is rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite, in a new ground of rejection. Claim 177 is amended to add the word –of–.

Claims 166-168, 177, 187, and 190-193 are rejected under 35 U.S.C. § 112, as allegedly failing to comply with the written description requirement.

The Board reversed this rejection as having failed to be supported by a prima facie case. In fact, it is respectfully submitted that these claims do properly comply with the written description requirement.

Claim 168 provides a system for selecting media items, comprising:

      (a)   a user interface for receiving a selection of a media item and for delivering a response to the selection (page 6, lines 15-29, page 70, lines 17-20, page 94, lines 13-19, page 136, line 29-page 137, line 1, page 170, line 16-page 172, line 16, page 227, line 27-page 228, line 6, 2405, 2401);

      (b)   a processor for automatically searching media items available for selection and for presenting a recommendation of at least one available media item, based on a degree of correspondence of said selection and content characteristics of available media items input independently of a human user (page 92, lines 1-25, page 115, lines 3-20, page 137, lines 23-27, page 167, lines 2-6, page 170, line 16-page 171, line 27, page 173, lines 11-20, page 227, line 27 - page 228, line 6, Fig. 17, 2412, 2407); and

      (c)   an accounting database for recording commercial transaction data relating to selections received (page 81, lines 9-27, page 91, lines 23-30, page 140, line 24-page 141, line 4, page 189, lines 2-4).

Claim 177 provides a method for proposing media, comprising the steps of:

      storing data representing content characteristics of media previously selected (page 75, lines 16-30, page 223, lines 6-9, 2406), wherein the data representing characteristics of media previously selected are not input by a respective human user (page 114, lines 3-page 115, line 2, page 115, line 21-page 116, line 10, page 136, line 29-page 137, line 6, page 140, lines 19-23, page 145, lines 13-20, page 146, line 12-page 147, line 3, page 148, lines 3-12, page 170, line 16-page 171, line 13, page 227, line 27 – page 228, line 6 passim, 2410, 2411);

determining a set of available media programs, the set being associated with data representing content characteristics of members of the set of available media programs (page 114, lines 3-page 115, line 2, page 115, line 21-page 116, line 10, page 136, line 29-page 137, line 6, page 140, lines 19-23, page 145, lines 13-20, page 148, lines 3-12, page 161, line 23-page 162, line 3, page 170, line 16-page 171, line 13, page 227, line 27-page 228, line 6);

automatically determining a degree of correspondence between data representing content characteristics a member of the set of available media programs and the data representing content characteristics of previously selected media (page 92, lines 1-25, page 115, page 145, line 13-page 146, line 2 lines 3-20, Fig. 17, 2407, 2412); and

outputting an identification of at least one member of the set of available media programs having content characteristics corresponding to content characteristics of previously selected media in dependence on the automatically determined correspondence (page 68, lines 2-5, 23-27, page 69, line 27-page 70, line 16, page 94, lines 20-24, page 146, lines 2-11, page 161, line 23-page 162, line 3, page 176, lines 10-23, Fig. 31, 2405).

It is therefore respectfully submitted that claims 166-168, 177, 187, and 190-193 find ample support in the specification. It is noted that the specification clearly discusses that the various consistent features and embodiments are available for use with each other, and provides significant rationale for the combinations and subcombinations. It is therefore respectfully submitted that the claims are fully supported in the specification, and that the rejection should be withdrawn.

ART REJECTIONS

Claims 155-156 and 160-161 are rejected under 35 U.S.C. 35 U.S.C. § 102(e) as being anticipated by Vogel, US 5,253,066. Without prejudice or disclaimer, it is noted that the corresponding PCT application WO90/15507, apparently published on December 13, 1990, which would generally qualify as a rejection under 35 U.S.C. § 102(b).

This rejection was sustained by the Board, stating:

First, the Appellants argue that Vogel only discloses storing data representing previously selected media for a transiently stored time. App. Br. 34. Claim 155 recites "storing data representing previously selected media." Claim 155 does not define or restrict how long or where this data is stored. Further, we note that the searching step of claim 155 does not require the use of this data, but instead recites "data representing content characteristics of the previously selected media."

Applicants have amended claim 155 to recite: "persistently storing data describing available media and persistently storing data representing previously selected media, selected prior to a current selection", consistent with the rationale of the Board in reversing the rejection

of claim 179 (Claim 179 distinguishes the references because it includes "a step of determining a degree of correspondence of prior selection and a set of available media.") Therefore, claim 155, and dependent claims 156-160, 174 and 176, are believed patentable on at least this basis.

The rejection of claims 175, 177, and 178 under 35 U.S.C. § 102(e) was reversed *pro forma*. To address the issue raised in Applicants' request for reconsideration, claim 177 is amended to recite: "storing data representing <u>automatically extracted</u> content characteristics of media previously selected". Thus, claim 177 now distinguishes data which represents <u>automatically extracted</u> content characteristics. Since these are "automatically extracted", this does not include human-generated data, and thus the claim clearly distinguishes the references.

Claim 155 is also amended to adopt "automatically extracted content characteristics", and therefore is distinguishable from the art on this basis as well.

Claim 157 is amended in response to the Board decision, pp. 13-14 to make clearer the meaning of the "correspondence criteria".

Claims 160, 174-175, 178 are amended to provide proper antecedent basis for the claim phrase.
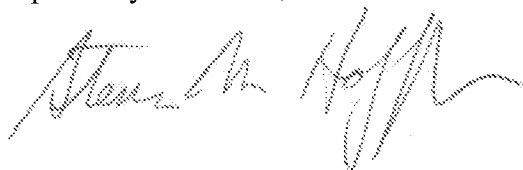
Claims 177 and 178 are amended to eliminate the word "programs", consistent with e.g., claim 182.

The rejection of claims 162-173, and 179-193 are reversed.

CONCLUSION

It is respectfully submitted that the application is in form for allowance, consistent with the Decision on Appeal from the Board of Patent Appeals and Interferences. If any issues remain outstanding, the Examiner is respectfully invited to call the undersigned for an Interview.

Respectfully submitted,

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